



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,091	01/24/2001	John Hsuan	13078.16US01	6403
23552	7590	03/14/2005	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			VIG, NARESH	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/769,091

Applicant(s)

HSUAN ET AL.

Examiner

Naresh Vig

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 January 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 - 7, 11, 14, 15 and 26 - 31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 7, 11, 14, 15 and 26 - 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This is reference to response received 11 January 2005 to the office action mailed 12 November 2005. There are 16 claims, claims 1 – 7, 11, 14, 15 and 26 – 31 pending for examination.

### ***Election/Restrictions***

Applicant's election without traverse of claims 1 – 7, 11, 14, 15 and 26 – 31 in the reply filed on 11 January 2005 is acknowledged.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6, 12 and 29 are rejected under 35 U.S.C. 112, first paragraph, because the specification, does not reasonably provide enablement for claimed limitations in the

Art Unit: 3629

claim. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

Regarding claim 2, Vargas does not teach establishing electronic contract of said resource provider.

Regarding claims 6 and 29, applicant recites "combining said resource provider with at least a certified provider from said certified resource database according to said business plans". In the disclosure originally filed on 24 January 2001, applicant discloses "The reliable resource provider can be certified and thereafter has priority rights on multitude of services provided by the business eHub system (step 42)".

Applicant has not clearly defined

- defining a priority of said business plan according to said matching combinations and said business models.
- combining of resource provider.

Appropriate correction is requested.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 – 5, 7, 11, 14, 26 – 27 and 30 rejected under 35 U.S.C. 102(e) as being unpatentable over Vargas et al. US Publication 2002/0046187 hereinafter known as Vargas.

Regarding claim 1, Vargas teaches system and method for speeding up founding establishment through Internet [0004, 0007, 0008, 0011]. Vargas teaches:

providing an electronic hub system capable of communicating with at least a resource provider [0011];

communicating said resource provider with said electronic hub system [0011];

examining a plurality of items of said resource provider [0008, 0011];

saving a record of said resource provider in said electronic hub system [0004, 0007, 0008, 0011]; and

matching said resource provider according to said record of said resource provider [0004, 0007, 0008, 0011].

Regarding claim 2, Vargas teaches establishing electronic contract of said resource provider (requires buyers and seller register [abstract, 0005, 0007, 0008], and,

Art Unit: 3629

it is known to one of ordinary skill in the art at the time invention that businesses have used agreements during registration process, for example registering with eBay.com, Amazon.com, Agency relationship in a real estate transaction etc.)

Regarding claim 3, Vargas teaches electronic hub and a data storage device (design choice) [Fig. 15 and disclosure associated with Fig. 3].

Regarding claim 4, Vargas teaches data storage device comprises a plurality of databases built therein (design choice) [Fig. 15 and disclosure associated with Fig. 3].

Regarding claim 5, defining what kind of data is being stored on the database, this is considered to be non-functional descriptive material that does not distinguish (define) over the applied prior art. Since the instant claims are article claims and the type of data claimed is considered to be non-functional descriptive material, the applied prior art satisfies the claim. The prior art stores data and is fully capable of storing the claimed type of data, this is the extend to which weight will be given to the claimed data. When descriptive material is not functionally related to the article, the descriptive material will not distinguish the invention from the prior art in terms of patentability, *In re Gulack*, 217 USPQ 401 (CAFC 1983).

Therefore, as responded to in response to claims 3 and 4, Vargas teaches plurality of database which can be configured and used to store information to meet business requirements:

Regarding claim 7, Vargas teaches provider comprises a capital provider [0007].

Regarding claim 11, Vargas teaches official document related to said resource provider [0004 – 0011].

Regarding claim 14, Vargas teaches:

logging in said electronic hub system [0015];

selecting a class for said resource provider [0004];

selecting a scope for said resource provider (business choice to decide how to categorize [0004];

assigning an identification number to said resource provider (business choice to decide how to identify resources [0006]; and

saving said record of said resource provider in said electronic hub system.

Regarding claim 26, Vargas teaches system for speeding up an establishment's foundation through Internet. Vargas teaches:

a data storage device having a plurality of databases built therein (design choice); and

an electronic hub connected to said data storage device through computer program, said electronic hub cooperated with said data storage device [Fig. 15 and disclosure associated with Fig. 15] capable to:

communicate with a resource provider [0004 – 0011];  
examine a plurality of items of said resource provider [0004 – 0011];  
save a record of said resource provider [0004 – 0011]; and  
match said resource provider according to said record of said resource provider  
and whereby speeds up said establishment's foundation [0004 – 0011].

Regarding claim 27, Vargas teaches electronic hub is further capable to establish an electronic contract of said resource provider [Fig. 15 and disclosure associated with Fig. 15].

Regarding claim 28, defining what kind of data is being stored on the database, this is considered to be non-functional descriptive material that does not distinguish (define) over the applied prior art. Since the instant claims are article claims and the type of data claimed is considered to be non-functional descriptive material, the applied prior art satisfies the claim. The prior art stores data and is fully capable of storing the claimed type of data, this is the extend to which weight will be given to the claimed data. When descriptive material is not functionally related to the article, the descriptive material will not distinguish the invention from the prior art in terms of patentability, *In re Gulack*, 217 USPQ 401 (CAFC 1983).

Therefore, as responded to in response to claims 3, 4 and 5, Vargas teaches plurality of database which can be configured and used to store information to meet business requirements:



Art Unit: 3629

Vargas teaches databases comprise:

Regarding claim 30, Vargas teaches:

log in said electronic hub for said resource provider [0015];

select a class (category) for said resource provider [0004];

select a scope for said resource provider [0006];

assign an identification number to said resource provider (business choice to decide how to categorize [0004]; and

save said record of said resource provider in said resource database.

### ***Claim Rejections - 35 USC § 103***

Claims 6, 15, 29 and 31 rejected under 35 U.S.C. 103(a) as being unpatentable over Vargas et al. US Publication 2002/0046187 hereinafter known as Vargas in view of Food Market Exchange hereinafter known as FME.

Regarding claim 6, Vargas teaches:

combining resource provider according to said business plans [0004 – 00011];

forming a plurality of match combinations for said resource provider [0004 – 00011];

comparing said match combinations with said business models from said business model database [0004 – 00011];

Vargas does not teach combining resource provider with at least a certified provider from said certified resource database according to said business plans. However, Official notice it taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that it is a business choice to decide how to conduct the certification, and, how the trading is conducted on their system. FME teaches that users are certified before they can use the system to conduct trade with other users, and provides additional banking and insurance services (combining 2 resource providers for conducting business) [page 10, 14];

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Vargas as taught by FME to ensure that the providers are eligible to conduct business.

Vargas in view of FME teaches defining a priority (within the scope of the applicant's disclosure in the application originally filed 24 January 2001) of said business plan according to said matching combinations and said business models.

Regarding claim 15, Vargas teaches saving record of said resource provider in said electronic hub system. Vargas does not teach examining said items of said resource provider; certifying said resource provider according to examining said items; However, Official notice it taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that it is a business choice to decide how

Art Unit: 3629

to conduct the certification, and, how the trading is conducted on their system. FME teaches that users are certified before they can use the system to conduct trade with other users [page 14].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Vargas as taught by FME to ensure that the providers are eligible to conduct business.

Regarding claim 29, Vargas teaches  
form a plurality of match combinations for said resource provider;  
compare said match combinations with said business models from said business model database;

Vargas does not teach combining resource provider with at least a certified provider from said certified resource database according to said business plans. However, Official notice it taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that it is a business choice to decide how to conduct the certification, and, how the trading is conducted on their system. FME teaches that users are certified before they can use the system to conduct trade with other users, and provides additional banking and insurance services (combining 2 resource providers for conducting business) [page 10, 14];

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Vargas as taught by FME to ensure that the providers are eligible to conduct business.

Vargas in view of FME teaches defining a priority (within the scope of the applicant's disclosure in the application originally filed 24 January 2001) of said business plan according to said matching combinations and said business models.

Regarding claim 31, Vargas teaches saving record of said resource provider in said electronic hub system. Vargas does not teach examining said items of said resource provider; certifying said resource provider according to examining said items; However, Official notice it taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that it is a business choice to decide how to conduct the certification, and, how the trading is conducted on their system. FME teaches that users are certified before they can use the system to conduct trade with other users [page 14].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Vargas as taught by FME to ensure that the providers are eligible to conduct business.

### ***Conclusion***

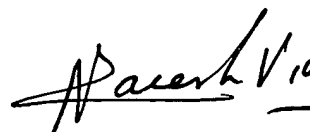
Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

Art Unit: 3629

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is 703.305.3372. The examiner can normally be reached on M-F 7:30 - 5:00 (Alt Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703.308.2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Naresh Vig', with a stylized flourish at the end.

Naresh Vig  
Patent Examiner  
March 08, 2005